REMARKS

This is a full and timely response to the outstanding final Office Action mailed May 9, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I.   Claim Rejections - 35 U.S.C. § 102(e)

Claims 1-20 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson, et al. ("Anderson '749," U.S. Pat. No. 6,680,749) or, in the alternative, as being anticipated by Anderson ("Anderson '538," U.S. Pat. No. 6,222,538). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is taught or suggested in either cited reference. Applicant first discusses Anderson '749, and then Anderson '538.

A.   Anderson '749

Anderson '749 discloses a method and system for integrating an application user interface with a digital camera user interface. Anderson '749, Patent Title. Nearly the entirety of the Anderson '749 disclosure is dedicated to describing various aspects of the interface of Anderson's digital camera. In addition, in column 12, Anderson states the following:

In a second embodiment of the present invention, an application program 760 may be loaded into the digital camera either from removable memory 354 (FIG. 3), or downloaded from a host computer or from a network to run in place of the control application 760.
[Anderson '749, column 12, lines 14-19]

Anderson does not appear to say anything else about receiving software with a digital camera from a network.

Applicant notes that Anderson '749 falls far short of anticipating Applicant's claims 1-20. In particular, as the following discussion elucidates, Anderson does not teach providing software to a digital camera, or other appliance, the software facilitating communication between the appliance and another device.

1.   Claims 1-8

Independent claim 1 provides as follows (emphasis added):

1.   An image capture appliance configured for connection to a network and communication with a device connected to the network, the appliance comprising:

a processing device configured to control operation of the image capture appliance;

memory including *logic configured to receive software* via the network *that facilitates communication between the image capture appliance and the device from a software source*; and

a network interface device with which the image capture appliance communicates with the software source.

Regarding claim 1, Applicant notes that Anderson '749 does not teach an image capture appliance that includes "logic configured to receive software . . . that facilitates communication between the image capture appliance and [a] device". Contrary to that alleged in the Office Action, column 12, lines 14-19 of Anderson '749, which is reproduced above, does not provide such a teaching. Instead, that portion of Anderson '749 teaches, and only teaches, downloading an "application program 760" from a network. Nowhere does Anderson state that the "application program 760" facilitates communication between Anderson's digital camera and another device. Again, 35 U.S.C. § 102 requires that an applied reference teach *each and every* limitation of the claim that is being rejected. Clearly, Anderson '749 fails to do so. Accordingly, the rejection is improper and should be withdrawn as to claims 1-8.

Applicant's dependent claims also contain their own limitations that are not anticipated by Anderson '749. For example, in regard to claim 5, Anderson '749 does not teach an appliance that is adapted to "periodically search for software for the appliance".

2. Claims 9-14

Independent claim 9 provides as follows (emphasis added):

9. An appliance configured for direct connection to a network and communication with a device connected to the network, the appliance comprising:

a processing device configured to control operation of the appliance;

an acquisition module adapted to receive software that facilitates communication between the appliance and the device from a software source; and

-9-

a network interface device with which the appliance communicates with the software source

wherein the appliance is one of an image capture appliance, a personal digital assistant, and a mobile telephone.

Regarding claim 9, Anderson '749 does not teach an appliance comprising an acquisition module that is adapted to "receive software that facilitates communication between the appliance and [a] device" for reasons described above in relation to claim 1. Accordingly, the rejection is improper and should be withdrawn as to claims 9-14.

Applicant's dependent claims also contain their own limitations that are not anticipated by Anderson '749. For example, in regard to claim 12, Anderson '749 does not teach an appliance that is adapted to "periodically search for software for the appliance".

3.   Claim 15

Independent claim 15 provides as follows (emphasis added):

15.   A network storage device, comprising:

a processing device configured to control operation of the device;

memory including *logic configured to receive software that facilitates communication between a digital camera and a separate network device*, and including *logic configured to transmit software to the network appliance*; and

a network interface device with which the network storage device communicates with the network appliance.

Regarding claim 15, Anderson '749 does not teach "logic configured to receive software that facilitates communication between a digital camera and a separate

network device" or "logic configured to transmit software to the network appliance". As is mentioned above, Anderson's digital camera is not described as receiving software that facilitates communication between a digital camera and another device, and Anderson identifies no other device that transmits that software to Anderson's digital camera. Accordingly, the rejection is improper and should be withdrawn as to claim 15.

4. Claims 16-20

Independent claim 16 provides as follows (emphasis added):

16. A method for enabling communications between an appliance and a separate device, wherein the appliance is one of an image capture appliance, a personal digital assistant, and a mobile telephone, the method comprising:

automatically receiving software with the appliance that facilitates communication between the appliance and the separate device; and

storing the software in memory of the appliance such that the appliance is adapted to communicate with the separate device.

Regarding claim 16, Anderson '749 does not teach "automatically receiving software with the appliance that facilitates communication between the appliance and the separate device" or "storing the software in memory of the appliance such that the appliance is adapted to communicate with the separate device" for reasons described above. Accordingly, the rejection is improper and should be withdrawn as to claims 16-20.

Applicant's dependent claims also contain their own limitations that are not anticipated by Anderson '749. For example, in regard to claim 18, Anderson '749 does not teach an appliance that is adapted for "automatically searching for software over a network to which the appliance is connected". Furthermore, in regard to claim 19, that searching is not "conducted on a periodic basis". Moreover, regarding claim 20, Anderson '749 does not teach that searching for software used to facilitate communication with a separate device is conducted "in response to a communication from the separate device".

Due to the shortcomings of Anderson '749 described in the foregoing, Applicant respectfully asserts that Anderson '749 does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

B.   Anderson '538

Anderson '538 discloses directing image capture sequences in a digital imaging device using scripts. Anderson '538, Patent Title. More particularly, Anderson '538 discloses controlling user interaction in a digital imaging device using dynamic overly bars. Therefore, like Anderson '749, Anderson '538 describes systems and methods for providing a user interface on a digital camera. Nowhere is it stated in Anderson '538 that the digital camera receives software that facilitates communication between the appliance and another device.

Regarding independent claim 1, Anderson '538 does not teach an image capture appliance that includes "logic configured to receive software . . . that facilitates communication between the image capture appliance and [a] device". That Anderson '538 teaches "installing selected application programs for running on the digital camera"

-12-

as is alleged in the Office Action does not mean that Anderson '538 teaches logic configured to receive software that facilitates communication between the image capture appliance and another device. Furthermore, in regard to Figure 11 of Anderson '538, Anderson only teaches searching for "system files on the removable memory 354" of the digital camera. Accordingly, the rejection is improper and should be withdrawn as to claims 1-8.

With specific regard to dependent claim 5, Anderson '538 does not teach an appliance that is adapted to "periodically search for software for the appliance".

Regarding independent claim 9, Anderson '538 does not teach an appliance comprising an acquisition module that is adapted to "receive software that facilitates communication between the appliance and [a] device" for reasons described above in relation to claim 1. Accordingly, the rejection is improper and should be withdrawn as to claims 9-14.

With specific regard to dependent claim 12, Anderson '538 does not teach an appliance that is adapted to "periodically search for software for the appliance".

Regarding independent claim 15, Anderson '538 does not teach "logic configured to receive software that facilitates communication between a digital camera and a separate network device" or "logic configured to transmit software to the network appliance". As is mentioned above, Anderson's digital camera is not described as receiving software that facilitates communication between a digital camera and another device, and Anderson identifies no other device that transmits that software to Anderson's digital camera. Accordingly, the rejection is improper and should be withdrawn as to claim 15.

Regarding independent claim 16, Anderson '538 does not teach "automatically receiving software with the appliance that facilitates communication between the

appliance and the separate device" or "storing the software in memory of the appliance such that the appliance is adapted to communicate with the separate device" for reasons described above. Accordingly, the rejection is improper and should be withdrawn as to claims 16-20.

With specific regard to dependent claim 18, Anderson '538 does not teach an appliance that is adapted for "automatically searching for software over a network to which the appliance is connected". Furthermore, in regard to dependent claim 19, that searching is not "conducted on a periodic basis". Moreover, regarding dependent claim 20, Anderson '538 does not teach that searching for software used to facilitate communication with a separate device is conducted "in response to a communication from the separate device".

Due to the shortcomings of Anderson '538 described in the foregoing, Applicant respectfully asserts that Anderson '538 does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

II.   Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-20 have also been rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the following combinations of references:

(i) Anderson '749 in view of Anderson, et al. ("Anderson '122," U.S. Pat. No. 6,567,122),

(ii) Anderson '749 in view of Anderson, et al. ("Anderson '259", U.S. Pat. No. 6,636,259),

(iii) Anderson '538 in view of Anderson '122, and

(iv) Anderson '538 in view of Anderson '259.

Applicant respectfully traverses these rejections.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art at least does not teach or suggest all of the claim limitations.

As is identified above in reference to the rejections under 35 U.S.C. § 102, neither Anderson '749 nor Anderson '538 teach or suggest an appliance that receives software that facilitates communication between the appliance and another device. Therefore, unless one or both of Anderson '122 and Anderson '259 provide that missing
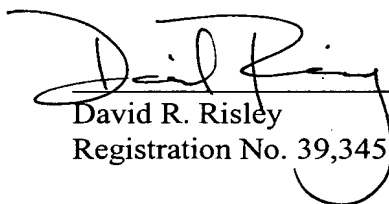
teaching or an appropriate suggestion, the rejections are improper as not teaching or suggesting all of Applicant's claim limitations as per MPEP §2143.

Applicant first notes that the Office Action does not state that either Anderson '122 or Anderson '259 provides a teaching, or a legitimate suggestion, of receiving with or providing to an appliance software that facilitates communication between the appliance and another device. Second, Applicant asserts that neither Anderson '122 nor Anderson '259 provides such a teaching or suggestion. Therefore, the proffered combinations do not teach or suggest all of Applicant's claim limitations, and the Office Action fails to state a *prima facie* case of obviousness. It is accordingly respectfully submitted that each of Applicant's claims is patentable over the cited references and that the rejections of these claims should be withdrawn.
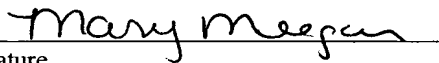
CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

David R. Risley
Registration No. 39,345

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7-6-05

Mary Meepan

Signature